

## **REMARKS**

### **I. Prosecution History**

Claims 1-13 were presented for examination by Applicant's filing of a nonprovisional application on January 16, 2004. Under the first non-final Office Action, dated October 4, 2007, claims 1-13 were rejected under 35 U.S.C. 102(e) as being anticipated by Murren et al. (US Pub No 2003/0110085). Applicant amended claims 1, 6, 12 and 13 and requested reconsideration of the application.

Claims 1-13 were then finally rejected in a final Office Action, dated April 29, 2008, under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (2002/0007374). Applicant cancelled claims 7 and 8 and amended claims 6, 9, 10, 11 and 12 to place the application in condition for allowance.

Under the Office Action, dated July 24, 2008, claims 1-13 were rejected and the amendments to claims 6 and 12 were not entered. The Examiner maintained the rejection to claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks. Applicant filed a Request for Continued Examination.

Under the non-final Office Action, dated December 3, 2008, the finality of the previous office action was withdrawn and amendments submitted by Applicant on August 28, 2008, were entered. Claims 1-13 were rejected as being unpatentable over Murren in view of Marks.

Under the Office Action, made final, dated June 5, 2009, claims 1-6 and 9-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Murren in view of Marks and instant invention background. On March 2, 2009, Applicant Requested for Continued Examination, along with amendments to the claims 1-6 & 9-15, cancellation of claims 7 & 8, and added new claims 16 and 17.

Under the Non-Final Office Action, dated October 28, 2009, the finality of the previous office action was withdrawn and amendments submitted by Applicant on October 1, 2009, were entered. Claims 2-6 & 9-15 were cancelled and previously rejected claim 1 and new claims 16 & 17 were rejected as being unpatentable over Murren in view of Marks and instant invention background.

Claims 1 and 16 were amended to further limit the claimed invention by adding the limitation “wherein communication is all accomplished via multicast to subscribers by publisher enterprise equipment.” The applicant would like to draw the Examiners attention to paragraph [0002] which states that the Marks et al invention “relates to a method and apparatus for supporting a multicast response to a unicast request to a document.” The Applicant argues that by adding the phrasing “wherein communications is all accomplished via multicast to subscribers” that the prior art is required to possess multicasting throughout the communication schema in order to disclose the claimed invention.

## **II. Claim Rejections – 35 U.S.C. §103**

### ***Requirements for Prima Facie Obviousness***

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”

The U.S. Supreme Court ruling of April 30, 2007 (KSR Int'l v. Teleflex Inc.) states:

“The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.”

“To facilitate review, this analysis should be made explicit.”

The U.S. Supreme Court ruling states that it is important to identify a reason that would have prompted a person to combine the elements and to make that analysis explicit. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. a reasonable expectation of success; and
2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the examiner of a reason to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

### ***Murren in view of Marks***

Claims 1, 16, and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Murren (US Pub No. 2003/0110085) in view of Marks (US Pub No. 2002/0007374) and the background of the invention.

Regarding claim 1, the Examiner argues that Murren discloses maintaining synchronization of information published to multiple subscribers, comprising: publishing print-ready document library subject availability via multicast communication over a data network using a multicast communication transport layer wherein said subject availability is predefined; receiving subscriptions for print-ready document library subjects via point-to-point data communication over the data network from remote subscribers at individual sites wherein said subscriptions comprise a configuration file that functions as a lookup table for subjects subscribed to by subscribers; instantaneously, at time of repository change, synchronizing data representative of the print-ready document with remote subscribers at individual sites over the data network using a multicast communication transport layer; and printing said print ready document at said individual sites.

Regarding claim 16, the Examiner argues that Murren discloses a system for managing distributed multi-site Print Ready Document libraries comprising: at least one database; at least one print ready document library wherein documents are assigned to predefined topics stored within said at least one database; a data network configured to publish availability of said predefined topics to a plurality of

print service sites wherein said print service sites subscribe to at least one of said predefined topics utilizing a configuration file conveyed over said data network; at least one server configured to access said predefined topics stored within said at least one database; enterprise communication equipment comprising a router and a network access device utilizing a multicast communication transport layer configured to automatically send print-ready documents to said plurality of print service sites in accordance with said predefined topics that each of said plurality of print service sites subscribed to; publish-subscribe middleware configured to enable said at least one server to operate in conjunction with said at least one database in order to manage subscriber data, topic data and publication-subscription logs; at least one rendering device located at each of said print service sites configured to render said print-ready documents.

Regarding claim 17, the Examiner argues that Murren discloses a system for managing distributed multi-site Print Ready Document libraries as detailed in claim 16 above and further argues that Murren discloses instantaneously synchronizing data representative of said print-ready document with said plurality of print service sites over the data network.

However, the Examiner admits Murren fails to disclose a print-ready document, and continues with the assertion that this is well known in the art as evidenced by the background of the invention. The Examiner further argues that the background of the invention discloses already print formatted mater documents that may be transmitted to a printer directly, which eliminates a need to repeat conversion and decomposition process of another copy if desired. Therefore, the Examiner continues, it would have been obvious to one of ordinary skill at the time of invention to have a print ready document incorporated in the device of Murren, as modified by the features of Marks, in order to eliminate the need to repeat the conversion or decomposition process if another copy of the document is needed.

Although *admitting* Murren et al fail to disclose a data network using a multicast communication transport layer and a print-ready document transmission medium, the Examiner further argues that print-ready document scenario is well known in the art as evidenced by the background of the invention, as well "multicasting" as taught by Marks et al. and further adds that Marks et al network

technology shares the same field of endeavor as Murren and instant invention, culminating in the rejection of claims 1, 16, and 17.

Continued arguments assert that the background of the invention discloses already print formatted matter documents that may be transmitted to a printer directly, which eliminates a need to repeat conversion and decomposition process of another copy if desired; therefore, it would have been obvious to one of ordinary skill at the time of invention to have a print ready document incorporated in the device of Murren, as modified by the features of Marks, in order to eliminate the need to repeat the conversion or decomposition process if another copy of the document is needed.

Applicant submits that the rejection fails to identify required reasoning [from the base reference] that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does, as also required for *prima facie* obviousness. Case in point, Murren neither aspires to reorganize the delivery of information packets nor is it necessary in providing a service that provides a prioritized search scheme applied to, e.g., the sale of cars (see paragraph [0021]). The examiner states that it would be obvious to one of ordinary skill in the art at the time of the invention was made to have the feature of a data network using a multicast communication transport layer incorporated in the device of Murren in order to have a one-to-many transmission protocols used in the transmission of data within the Murren system. As required by the MPEP the Examiner is required to provide motivation from within the reference, teaching the incorporation of "multicasting" to the Murren et al invention to provide a reasonable expectation for the combination of Murren et al in view of Marks et al to perform the function as the claimed invention.

The Applicant respectfully asserts that the motivation provided in the Non-Final Office Action, dated October 28, 2009, for combining Murren in view of Marks et al (see page 9, first paragraph and pages 13-14, joining paragraph) is derived from a Marks et al recitation. The Applicant considers the gathering of motivational insights from the Marks et al reference as impermissible hindsight since the Examiner gleans no reasoning for warranting the combination from Murren et al. On the contrary, the instant application is built from a foundation of multicasting

intertwined with print ready documents to provide network architecture to clamp down on superfluous data transfers by consolidating packet exchanges within a prepress commercial framework leveraged by time. Transmitting print-ready documents through a multicast network has clear intentions that are not shared in Murren.

Applicant further submits that reasonable expectation of success is not advanced by the rejection because Murren and Marks et al teach away from the general principles of print-ready document scenarios. To further support this assertion the Applicant would like to put into context the term "print-ready documents" by referring to Prior Art document authored by inventor Harkins et al (PN 5513126), column 3, lines 6-19, and therein is establishes a framework describing a "print-ready" document with phrasing "Already print formatted or master documents, that may be transmitted to the printer directly, eliminating the need to repeat the conversion or decomposition process if another copy of the document is desired. If saved, an "Interpress TM" master can be stored at the file service or even mailed to one or more individuals via an electronic mail service. Utilizing an internetwork routing service, users can transmit "Interpress" TM or other printing masters through a network and then across an internet, typically, via telephone lines, twisted pair wires, coaxial 15 cables, microwaves, infrared, and/or other data links, allowing documents created in one location to be automatically routed to a print service and printer hundreds or even thousands of miles away, in seconds or minutes."

However, as defined above and in instant application background, the motivation to incorporate this technology into Murren is lacking. As Murren et al discusses in paragraph [0023] the subscribed information is stored locally and eventually printed out as flyers. The Applicant respectfully asks the Examiner what incentive would be in place to convert this system to "print ready document" transmissions versus standard document handling as intended by Murren et al. Print-ready document transmission was developed for the situation where multiple documents are delivered from remote locations in commercial applications, where time is of essence and the attaching PDL files can further streamline the process,

contrary to the incentives derived from printing locally stored documents as taught my Murren et al (see paragraph [0023]).

Therefore, the Applicant respectfully disagrees with this assessment and traverses the rejections of claims 1, 16 and 17. To further distinguish the instant invention from the submitted prior art the Applicant submits herein amendments to claims 1 and 16, both adding the limitation "wherein communication is all accomplished via multicast to subscribers by publisher enterprise equipment". Applicant submits that neither Murren nor Marks et al, nor the background of Applicant's application disclose or suggest communication is all accomplished via multicast to subscribers by publisher enterprise equipment. Thus, because Murren, Marks and the background all fail to disclose or suggest all of the limitations of Applicant's amended claims 1, 16, and previously added dependent claim 17 are considered allowable since the rejections fail to meet the requirements for *prima facie* obviousness as discussed above.

Applicant reminds Examiner that the Federal Circuit held that "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious" *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). Therefore, it is unlikely that one having ordinary skill in the art at the time of invention would have been successful in modifying the teachings of Murren with the teachings of Marks to successfully achieve Applicant's device as claimed. The present invention contains elements not disclosed in the prior art, as well as all communications accomplished via multicast to subscribers by publisher enterprise equipment, not merely a combination of unicast and multicast as disclosed by Marks et al in paragraph [0021]. For these reasons, Applicant submits that the invention as a whole is not obvious. Based in the foregoing, Applicant submits that the rejection of claims 1 and 16 are traversed based on the above arguments and Applicant respectfully requests withdrawal of the rejection of claims 1, 16 and 17.

### **III. Conclusion**

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Non-Final Office Action dated October 28, 2009. The Applicant has clarified the structural distinctions of the present invention and now respectfully request the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Luis M. Ortiz at 505-314-1311 to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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Kermit D. Lopez  
Attorney for Applicants  
Registration No. 41,953  
ORTIZ & LOPEZ, PLLC  
P.O. Box 4484  
Albuquerque, NM 87196-4484